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EXAMINER

WOO, RICHARD SUKYOON

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 07/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/474,642

Applicant(s)

FOTH, THOMAS J.

Examiner

Richard Woo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 December 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2-3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

- 1) The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description:

"25A", "25B" and "25C" in Fig. 2; and

"100" through "120" in Fig. 3.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

- 2) The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 3) Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claims 1, 7 and 10, respectively, the recitation of "facilitating refunds" or "refunding the postage amount to a user" renders the claim indefinite and vague because it is not clear whether the Applicant's postage metering system actually refunds the spoiled postage amount from the Post Office, or diverts the fund from the additional private account (called a dispute account), which is associated with a

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corresponding one of the user accounts, to user. If the dispute account were set up by the user (not by the Post Office), the reimburse process could not constitute the **refund** because the user got his/her money back from his/her other account, not from the Post Office. If the Post Office set up the dispute account, any user could abuse the system by requesting the refund without the process of authenticated by the Post Office. Accordingly, the Applicant particularly fails to point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 8, line 3, the recitation of "the computer" lacks antecedent basis.

Claim Rejections - 35 USC § 101

- 4) 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

- 5) Claims 1-10 are rejected under 35 U.S.C. 101 as being directed to nonstatutory subject matter. C.f. *In re Schrader*, 30 USPQ2d 1455 (Fed. Cir. 1994). The Claims 1, 7 and 10, respectively, merely manipulate an abstract idea without producing a "useful, concrete and tangible result, which is facilitating refunds in a postage metering system."

The subject matter as claimed by the Applicant would not produce the useful, concrete and tangible postage meter refund. The refund can be processed from only the Post Office after receiving the refund request from the user and authenticating the request. The Applicant's invention including a dispute account, which is associated with the corresponding user's account, may not be able to constitute the actual refund process. Since the user is simply getting his/her money back from his/her other

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account, the user may have to go to the Post Office eventually to get his/her refund.

Accordingly, the Applicant's claimed subject matter can't produce the useful, concrete and tangible refund from the Post Office.

Claim Objections

6) Claims 7-9 are objected to because of the following informalities:

In Claim 7, line 6, "data base" should be changed to --database--.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

7) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8) Claims 7-8, as far as they are definite, are rejected under 35 U.S.C. 102(e) as being anticipated by EP 927,956 (hereinafter EP '956).

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EP '956 discloses a postage metering system comprising:

a postage meter having a vault that accounts for postage dispensed by the postage meter (see Fig.1);

a data center (5) in communication with the postage meter, the data center having a CPU and an account database;

means (26) for permitting communication between the postage meter and the data center,

wherein the CPU determines a refund of postage;

a printing device; and

the CPU unit refunding the postage amount to a user of the postage meter.

EP '956 further discloses a computer-readable medium having computer-executable code for performing the steps of refunding.

9) Claims 7-8, as far as they are definite, are rejected under 35 U.S.C. 102(e) as being anticipated by Whitehouse (US 6,005,945).

Whitehouse discloses a postage metering system comprising:

a postage meter having a vault that accounts for postage dispensed by the postage meter (see Fig.1);

a data center (102) in communication with the postage meter, the data center having a CPU and an account database;

means (11.c) for permitting communication between the postage meter and the data center,

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wherein the CPU determines a refund of postage;
a printing device; and
the CPU unit refunding the postage amount to a user of the postage meter.

Whitehouse further discloses a computer-readable medium having computer-executable code for performing the steps of refunding.

Claim Rejections - 35 USC § 103

10) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11) Claims 1-6 and 9, as far as they are definite, are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 927,956 (hereinafter EP '956).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR

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1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Regarding Claims 1-6, EP '956 discloses the method having the steps of:

receiving a refund request;

verifying the request via a computer;

sending the refund request to a postal authority by a data center;

refunding the postage amount to a user of the postage meter;

adjusting the user's account to reflect the refund; and

rejecting the refund by sending a disable message when the refund request has not been verified.

However, EP '956 does not expressively disclose:

the method of determining if a value in the user's account is acceptable for permitting a refund of the postage amount;

sending enabling data from the computer to the postage meter to effectuate the refund; and

the method of mailing funds equivalent to the postage amount to the user; and

As long as the Post Office can authenticate whether the user has a compelling reason for the refund and the user has a valid account, any user's account is acceptable for permitting the refund of the postage amount. In order to effectuate the refund, the data transmission between the data center and the postage meter is clearly required. As Fig. 1 of EP '956 shows the diagram depicting that the data center is communicating with the postage meter, it is well known in the art to send data from one computer to the other to communicate so as to execute the program, such as refunding the money to the user. Furthermore, the difference, whether refunding the money to user by the electronic means (via the account) or mailing, would not be distinguished from the prior art in terms of patentability.

Accordingly, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to verify the authenticity of the user's account, send data from the data center's computer to the postage meter, and mail refunds equivalent to the postage amount to the user (because mailing the refund to the user does not patentably distinguish the claimed invention), for the purpose of refunding the money equivalent to the postage amount to the user.

Regarding the Claim 9, EP '956 discloses the invention as cited earlier, but does not expressively disclose the postage metering system having the printing device printing a receipt of the postage amount refunded.

It is well known in any art of retailing business to print the receipt for the record of refunding by the request of the customer (or the user).

Accordingly, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to print the receipt of the postage amount refunded because printing the receipt for the user does not patentably distinguish the claimed invention.

9) Claims 1-6 and 9, as far as they are definite, are rejected under 35 U.S.C. 103(a) as being unpatentable over Whitehouse (US 6,005,945).

Regarding the Claims 1-6, Whitehouse discloses the method having the steps of:

receiving a refund request;

verifying the request via a computer;

sending the refund request to a postal authority by a data center;

refunding the postage amount to a user of the postage meter;

adjusting the user's account to reflect the refund; and

rejecting the refund when the refund request would not be authenticated.

Whitehouse does not expressively disclose:

the method of determining if a value in the user's account is acceptable for permitting a refund of the postage amount;

sending enabling data from the computer to the postage meter to effectuate the refund; and

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the method of mailing funds equivalent to the postage amount to the user; and

As long as the Post Office can authenticate whether the user has a compelling reason for the refund and the user has a valid account, any user's account is acceptable for permitting the refund of the postage amount. In order to effectuate the refund, the data transmission between the data center and the postage meter is clearly required. As Fig. 1 of Whitehouse shows the diagram depicting that the data center is communicating with the postage meter, it is well known in the art to send data from one computer to the other to communicate so as to execute the program, such as refunding the money to the user. Furthermore, the difference, whether refunding the money to user by the electronic means (via the account) or mailing, would not be distinguished from the prior art in terms of patentability.

Accordingly, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to verify the authenticity of the user's account, send data from the data center's computer to the postage meter, and mail refunds equivalent to the postage amount to the user (because mailing the refund to the user does not patentably distinguish the claimed invention), for the purpose of refunding the money equivalent to the postage amount to the user.

Regarding the Claim 9, Whitehouse discloses the invention as cited earlier, but does not expressively disclose the postage metering system having the printing device printing a receipt of the postage amount refunded.

It is well known in any art of retailing business to print the receipt for the record of refunding by the request of the customer (or the user).

Accordingly, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to print the receipt of the postage amount refunded because printing the receipt for the user does not patentably distinguish the claimed invention.

Conclusion

10) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 6,050,486 is cited to show a postage metering system having a plurality of accounting arrangements.

US 4,787,045 is cited to show a postage metering system having a recharging Feature.

EP 1,067,483 is cited to show the method and system of providing refunding a value of credit in the postage metering apparatus.

US 5,819,234 is cited to show a toll collection system having a refundable account.

US 4,097,923 is cited to show the Applicant's admitted prior art.

US 5,715,164 is cited to show the system and method for communications with postage meters in an encrypted and authenticated way.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Woo whose telephone number is 703-308-7830. The examiner can normally be reached on Monday-Friday from 8:30 AM -5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-308-3691 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.



Richard Woo
Patent Examiner
GAU 3629
June 24, 2002



John G. Weiss
Supervisory Patent Examiner
Group 3700